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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,024	03/29/2000	Subhankar Chatterjee	C-481B	6245

7590

07/16/2002

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EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 07/16/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/538,024

Applicant(s)

CHATTERJEE ET AL.

Examiner

Monique R Jackson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-51.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Continuation of Item No. 2. NOTE: The proposed amendment(s) will not be entered because they present an additional claim without canceling a corresponding number of finally rejected claims; they raise new issues that would require further consideration and/or search; and they are not deemed to place the application in better form by materially reducing or simplifying the issues for appeal. It is noted that the proposed amendment adds new claim 52 without canceling a corresponding finally rejected claim and incorporates the limitations “single fluid” and “efficiently irradiating...in a single step” into the process claims that previously did not require such limitations. Further, it is noted that the proposed amendment(s) do not place the application in better form by materially reducing or simplifying the issues for appeal particularly given that many of the previous issues remain, such as the new matter issue, in addition to the other issues noted above.

Continuation of Item No. 5. NOTE: Applicants’ request for reconsideration of the finality of the prior office action has been seriously considered but is not persuasive. Though the issue with regards to the radiation curing method being performed “in a single step” was discussed during the interview of June 13, 2001, the incorporation of additional limitations into the claims by amendment must be fully supported by the original disclosure at the time of the invention. Further, as noted in the interview summary, Paper No. 5, no agreement was reached with regards to patentability, and hence, the amended claim limitations presented in Amendment A filed 9/26/01, whether discussed during the interview or not, resulted in the new grounds of rejection presented in the Office Action dated 12/18/01, Paper No. 11. Therefore, in the interest of compact prosecution and as per MPEP § 706.07(a), the finality of the office action was proper

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given that the Applicants' amendment to overcome the prior art of the previous rejection, Stevenson, necessitated the new ground(s) of rejection presented in Paper No. 11. Applicants' request for reconsideration with regards to the limitation "in a single step" was fully considered, however, the Applicants' arguments are not persuasive. The Applicants argue that the limitation "in a single step" is not new matter and is fully supported by the original disclosure at the time of the invention based on the Applicants' disclosure at Page 11, lines 9-11 which states, "Once the aqueous coating composition is applied to the substrate surface, it is immediately cured without prior removal of the water, using either high energy electrons or UV radiation." However, the Examiner takes the position that this recitation does not support the limitation "in a single step" given that the recitation does not preclude the possibility that the curing can be performed in multiple radiation steps without prior removal of the water. The Applicants further argue that the curable composition of the instant invention is a single fluid aqueous composition and hence is not a dispersion as in the cited prior art. However, it is first noted that the proposed amendments incorporating this limitation into the process claims were not entered for the above stated reasons and therefore Applicants arguments with regards to the method claims are moot. Further, though the Applicants have provided an interview summary report from the prosecution of a previous application, now Patent 5,725,646, to provide a meaning of the phrase "single fluid" utilized in the instant application wherein the Examiner of that application replaced the phrase "non-emulsion, non-colloidal" with "single fluid", the Applicants cannot rely upon that interview summary as support for that definition in the instant invention particularly given that the phrase "single fluid" is not an art recognized term well known in the art to be only defined as suggested by the Applicants, the term "single fluid" was never clearly defined in the instant disclosure at

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the time filing and nowhere in the instant invention did the Applicants describe the invention as being non-emulsion or non-colloidal or not a dispersion. In fact, the original disclosure at the time of the invention does not reasonably suggest that the composition is a "single fluid" or single phase solution given that at Page 8, lines 21-27, the original disclosure states that the composition may further include colorants or pigments which are preferably solid pigments and dispersed therein, thereby resulting in a composition that includes the dispersed material and hence is not a single fluid or single phase solution. Hence, the Applicants arguments with regards to a "single fluid" are not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428.


The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



mrj
July 10, 2002.



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700